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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,503	02/09/2001	Sanjay Sethi	11520.0228	7097

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EXAMINER

LEARY, LOUISE N

ART UNIT

PAPER NUMBER

1654

DATE MAILED: 05/13/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/780,503

Applicant(s)

SETHI ET AL.

Examiner

Louise N. Leary

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-11 and 13-20 is/are rejected.
- 7) ☒ Claim(s) 3 and 12 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. Claims 1-20 are pending in this application.
2. The rejection of claims 1-2, 4-11, and 13-20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Tsang et al ("Chest"; V.117/2; February 2000) for reasons of record and because applicants have not provided sufficient evidence to show the invention claimed was made before the publication date of the Tsang et al prior art reference of record.
3. Applicant's arguments filed March 24, 2003 have been fully considered but they are not persuasive.

Applicant's request for reconsideration and arguments filed March 24, 2003 have been carefully considered. However, the examiner disagrees with applicant's assertion that the present application priority claim to the provisional application number 60/181,620, filed February 10, 2000 invalidates the February, 2000 publication date for the Tsang et al prior art reference. Specifically, applicants have asserted that a copy of the Tsang et al reference was received at the State University of New York at Buffalo's Health Science Library on February 22, 2000 and Tsang et al reference was available to the public after February 10, 2000. It is noted that the examiner agrees with the date the State University of New York at Buffalo's Health Science Library received a copy of the Tsang et al reference. However, the examiner does not find the date the copy was received at the Buffalo's Health Science Library to constitute sufficient evidence to render the February 2000 publication and priority date of the Tsang et al reference after February 10, 2000. Rather, the examiner finds the following:

- (1) the revised Tsang et al manuscript was accepted for publication on 7/15/1999;
- (2) the sale or offer for sale of the invention by an independent third party ("National Sales Representatives", see page A5 of the "CHEST" official publication) occurred more than

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one year before applicant's filing date of the provisional and before publication of the article in February, 2000;

(3) the date of receipt of the copy of the Tsang et al reference at the State University of New York at Buffalo's Health Science Library, February 22, 2000, does not represent the date which all "CHEST" subscribers received all copies of the Tsang et al reference in February 2000;

(4) the "CHEST" editorial division has informed examiner Leary that the Tsang et al article was published and distributed to numerous subscribers during the first two weeks of February, 2000; and

(5) applicants have not submitted a declaration or evidence swearing behind the publication date of the Tsang et al reference.

For the reasons given above, the rejection of claims 1-2, 4-11 and 13-20 under 35 USC 103(a) as unpatentable over Tsang et al has been maintained.

4. Claims 3 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louise N. Leary whose telephone number is (703) 308-3533. The examiner can normally be reached on Monday to Friday from 9:30 to 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached on (703) 306-3220. The fax phone number for the organization where this application or proceeding is assigned is (703)308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1235.

For a 24 hour application status update, please visit our website at www.uspto.gov and click on the button "Patent Electronic Business Center" for more information.


LOUISE N. LEARY
PRIMARY EXAMINER

May 5, 2003